REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the following remarks are respectfully requested.

Rejections under 35 USC § 103

The rejection of claims 1, 4, 7, 12-14 under 35 USC § 103(a) as being unpatentable over Fishbine et al. in view of Wakabayashi et al. is respectfully traversed.

This rejection relies on United States Patent No. 4,933,976 – Fishbine '976 (which is incorporated in column 7, lines 5-13, of the cited Fishbine et al. reference - hereinafter Fishbine '403), to disclose a swipe scanner. However, this reliance on Fishbine '976 to disclose swipe scanner is misplaced. Fishbine '976, in fact, discloses the use of the same type of static prism (finger prism 20) against which a finger is pressed and rolled from one side to the other. The scanning arrangement is set-up so that as the finger rolls, images from the portions of the finger which is in contact with the prism are scanned and the image is developed in three sections – see Fig. 6 wherein the rolling motion of the finger across the "finger prism 20." See also Figs. 2A, 3A, 4A, 2B, 3B, 4B, 2C, 3C and 4C.

Thus, not only does the Fishbine '976 reference not disclose or suggest swipe scanning (as it would be understood by the person of ordinary skill), it actually teaches toward the use of a specialized prism (viz., a "finger prism") which not only is adapted for a finger and finger print analysis, but is adapted in a manner wherein a medium (including sheets of paper and the like) could not be practically swipe scanned.

Note is had to the position taken on page 2 of the Office Action wherein it is stated that "the Fishbine reference meets the limitation of "being configured to move relative to the medium"." In an anticipation rejection under § 102 this "meets" position may have merit. However, the rejection is made under 35 USC § 103 and it will be apparent that with the Fishbine '976 arrangement, the medium moves (rolls) relative to the scanner (rather than scanner moving relative to the medium) and is still not a swipe scanner as would be understood by the hypothetical person of ordinary skill (as is necessary in a rejection under 35 USC § 103).

In a nutshell, the entire rejection hinges on the assumption that Fishbine '976 discloses a swipe scanning arrangement. However, position that element 18 in Fig. 7 would be understood by the hypothetical person of ordinary skill to be a swipe scanner, is in error and not at all suggested by the disclosure of either of Fishbine '403 or Fishbine '976.

All rejections which are based on Fishbine '403 are therefore defective for the very reason noted above – there is no swipe scanner disclosed or suggested. The teachings of Wakabayashi et al.; the "admitted prior art"; Lafreniere; Egawa; Anderson et al.; and Abram et al. do not rectify this fatal flaw.

For this reason, the rejections of claims 2, 3, 5, 6 and 8-11 will not be discussed individually and are traversed for at least the above reason and for the reasons advanced in the previous response.

Obviousness type Double Patenting

The rejection of claims 1, 4, 7 and 12-14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of USP 6,633,332 to Nay et al., in view of Wakabayashi et al. is traversed.

For obviousness type double patenting to occur, the invention defined in *a claim in the application* must be *an obvious variation of the invention defined in a claim in the patent*. See, e.g., *In re Berg*, 46 USPQ2d 1226 (Fed. Cir. 1998). In other words, the subject matter set forth in claims 1, 4, 7 and 12-14 of the instant application must be an obvious variant of the subject matter of *claim 4* of the '332 reference in view of the secondary reference to Wakabayashi et al.

Claim 4 of '332 requires that the system controller of claim 1 be configured to merge the first and second sets of digital data into a third set of digital data.

That is to say, claim 4 recites:

> The system of claim 1, wherein said system controller is further configured to merge said first and second sets of digital data into a third set of digital data.

At the top of page 12 of this office action it is states that "a system controller" - *presumably of claim 1 of this instant application, is* - "configured to store said first set of

digital data and said second set of digital data into said storage device" and further states that "wherein said system controller is further configure to merge said first and second sets of digital data into a third set of digital data" in claim 4 of the '332 patent.

This rejection therefore incorrectly assumes that storing the first and second sets of digital data "in association with each other" in a storage device (claim 1 of this instant application) does more than store the sets of data in a manner wherein they will be read in association with each other – viz., read out together still in the form of two sets of data. There is neither disclosure nor suggestion of any "merging" of the first and second sets of data in the storage nor disclosure of the formation of a "third set of data" anywhere in the rejected claims.

The rejection therefore fails. The fact is that the teachings of the secondary reference(s) would have to render the "de-merge" of the first and second sets of data obvious to the degree that the intended third set of data, which is recited in claim 4 of '332, would not formed.

All of the following rejections fail for at least the same reason.

Conclusion

The pending claims define patentable subject matter for at least the reasons advanced above. Accordingly, favorable reconsideration and allowance of this application is courteously solicited.

Respectfully submitted,

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